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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,758	05/14/2001	Yutaka Sasaki	F-6977	8921

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JORDAN AND HAMBURG LLP
122 East 42nd Street
New York, NY 10168

EXAMINER

CONNELLY CUSHWA, MICHELLE R

ART UNIT	PAPER NUMBER
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2874

DATE MAILED: 04/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,758

Applicant(s)

SASAKI ET AL.

Examiner

Michelle R. Connelly-Cushwa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

Seven (7) sheets of formal drawings were filed on May 14, 2001 and have been accepted by the Examiner.

Specification

The disclosure is objected to because of the following informalities:

On page 3, line 4, "rating filter" should be changed to --grating filter--;

On page 3, lines 7-8, "rating filter" should be changed to --grating filter--;

On page 7, line 1, "couple" should be changed to --coupler--;

On page 7, line 6, "couple" should be changed to --coupler--; and

On page 10, line 10, "couple" should be changed to --coupler--.

Appropriate correction is required.

Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claims 2 and 3 have not been further considered with respect to prior art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Shevy et al. (US 6,498,799 B1).

Regarding claim 1; Figure 4A of Shevy et al. discloses a device comprising two optical couplers (102A, 104A, 102B, 104B) of grating built-in type and two optical amplifiers (112A and 112B).

The recitation “add-drop multiplexer with signal amplification ability” in line 1 of claim 1 has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely

recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over
Freeman et al. (US 6,388,806 B1) in view of Kewitsch et al. (US 5,805,751).**

Regarding claim 1; Freeman et al. discloses all of the limitations of claim 1, except for the device comprising grating built-in type optical couplers. Figure 1 of Freeman et al. discloses a fiber amplifier system for WDM applications comprising two WDM optical couplers (32 and 34) and two optical amplifiers (12 and 16). Freeman et al. does not specify that any specific WDM optical couplers are to be used as the WDM optical couplers (32 and 34) in the invention.

WDM optical couplers of the grating built-in type are well known, readily available, and commonly used in the art. For example: Kewitsch et al. (US 5,805,751) discloses WDM optical couplers of the grating built-in type in Figure 20A; Sasaki (JP 11-271558) discloses a WDM optical coupler of the grating built-in type in Figure 1; Byron (US 5,638,473) discloses a WDM optical coupler in Figure 6 of the grating built-in type; Snitzer (US 5,459,801) discloses WDM optical couplers in Figures 1 and 2 of the grating

built-in type; and Gustavsson (US 6,374,019 B1) discloses WDM optical couplers of the grating built-in type.

Thus, one of ordinary skill in the art would have been familiar with WDM optical couplers of the grating built-in type and would have found it obvious to incorporate any well known WDM optical couplers, including those of the grating built-in type in the invention of Freeman et al.

Conclusion

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Meli et al. (US 5,701,194) discloses an amplifier telecommunication system for WDM transmissions in Figure 3 comprising two WDM couplers (12, 15) and amplifiers (7, 13, 9); Gavrilovic et al. (US 5,917,969) discloses a laser modulator including two optical couplers (20, 30) and an amplifier (40); Sugaya et al. (US 6,288,834 B1) discloses a system in Figure 17 including two WDM devices (5₁, 5₂) and amplifiers (1₁, 1₂, 1₃); and Sugaya et al. (US 6,400,499 B2) discloses a multi-

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wavelength device in Figure 1 comprising two amplifying optical fibers (7, 8) and WDM couplers (5₁, 5₂).

Any inquiry concerning the merits of this communication should be directed to Examiner Michelle R. Connelly-Cushwa at telephone number (703) 305-5327. Any inquiry of a general or clerical nature (i.e. a request for a missing form or paper, etc.) should be directed to the Technology Center 2800 receptionist at telephone number (703) 308-0956 or to the technical support staff supervisor at telephone number (703) 308-3072.

Michelle R. Connelly-Cushwa

MRC
April 2, 2003

Aula
AKM ENAYET ULLAH
PRIMARY EXAMINER